

Applicants: Ilya Trakht et al.
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REMARKS

Claims 6, 7, 9, 16-18 and 175-184 are pending in the subject application. By this Amendment, applicants have canceled claims 6, 16 and 175-180 without disclaimer or prejudice to applicants' rights to pursue the subject matter of these claims in a continuing application. Applicants have also amended claims 181-183. The amendment to claim 181 involves rewriting the claim in independent form and thus does not raise any issue of new matter. Similarly, no new matter is introduced by the amendments to claims 182 and 183. Accordingly, upon entry of this Amendment, claims 7, 9, 17, 18 and 181-184 will be pending.

Allowed Claims

Applicants acknowledge with appreciation the Examiner's statement on page 6, item 10 of the Office Action that claims 7, 9, 17 and 18 are in condition for allowance.

Rejections under 35 U.S.C. §103(a)

Claims 6 and 16

The Examiner maintained his rejection of claims 6 and 16 under 35 U.S.C. §103(a) as allegedly unpatentable over De Vries et al. (PNAS 95: 12340-12345, 1998) and Rousset et al. (Oncogene 16: 643-654, 1998) and as evidenced by the specification, and further in view of Campbell (Monoclonal Antibody Technology, Elsevier Science Publishers, pages 1-32, 1986) and Harlow et al. (Antibodies, A Laboratory Manual, Cold Spring Harbor Laboratory, page 322, 1988).

In response, and without conceding the correctness of the Examiner's position, applicants note that claims 6 and 16 have

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been canceled, thereby rendering the rejection of these claims moot.

Claims 175-180 and 182-184

The Examiner maintained his rejection of claims 175-180 and 182-184 under 35 U.S.C. §103(a) as allegedly unpatentable over De Vries et al. (PNAS 95: 12340-12345, 1998) and Rousset et al. (Oncogene 16: 643-654, 1998), and as evidenced by the specification, and further in view of Campbell (Monoclonal Antibody Technology, Elsevier Science Publishers, pages 1-32, 1986), Harlow et al. (Antibodies, A Laboratory Manual, Cold Spring Harbor Laboratory, page 322, 1988), Adair et al. (WO 91/09967, published July 11, 1991), Green et al. (Nature Genetics 7: 13-21, 1994) and Wei et al. (U.S. Patent No. 6,455,040, with priority to May, 1999).

In response, and without conceding the correctness of the Examiner's position, applicants note that claims 175-180 have been canceled, thereby rendering the rejection of these claims moot.

The Examiner stated on page 6, item 10 of the Office Action that claim 181 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

In response, applicants have rewritten claim 181 in independent form.

Applicants note that claims 182 and 183 have also been amended so that they, as well as previously presented claim 184, now depend directly or indirectly from claim 181, as amended. Since the Examiner stated that claim 181 would be allowable if rewritten in independent form, applicants maintain that claims 181-184, as

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amended, are in condition for allowance.

Rejection under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claim 16 under 35 U.S.C. 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner stated that claim 16 is indefinite for reciting "binds and forms a complex with TIP-2 located on the surface of fixed human cancer cells expressing TIP-2, wherein the monoclonal antibody binds intracellularly to TIP-2", because it is not clear how the antibody can bind on the surface of fixed cells and also bind intracellularly. The Examiner posed the question as to whether the antibody binds to the surface or intracellularly.

In response, and without conceding the correctness of the Examiner's position, applicants note again that claim 16 has been canceled, thus rendering the rejection thereof moot.

Conclusion

In view of the remarks made herein, applicants respectfully submit that the claims pending in this application are all in condition for allowance. Accordingly, allowance is earnestly requested.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is

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hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

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Reg. No. 37,399

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